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EXAMINER

MATTISON, LORI K

ART UNIT	PAPER NUMBER
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1619

NOTIFICATION DATE	DELIVERY MODE
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09/04/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/527,281	Applicant(s) MATEU ET AL.	
	Examiner LORI MATTISON	Art Unit 1619	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1619

DETAILED ACTION

The Group and/or Art Unit location of your application in the PTO has changed.

All correspondence regarding this application should be directed to Group Art Unit 1619.

Status of the Claims

Applicant's amendments filed 05/04/2009 to claims 1, 3, 5, 6, 10, and 11 have been entered. Claims 12-15 have been added. Claims 1-15 remain pending in the current application, of which claims 1-15 are being considered on their merits. References not included with this Office action can be found in a prior action. Any rejections of record not particularly addressed below are withdrawn in light of the claim amendments and applicant's comments.

Claim Objections

Claims 1, 10, 11, and 15 are objected to because of the following informalities: They are not in proper Markush format. M.P.E.P. § 2173.05(h) teaches that a Markush group has the format, "wherein R is a material selected from the group consisting of A, B, C and D." In the instant case, "from the group consisting of" is not included in the claims. Applicant may wish to consider amending the claims to recite "...from the group consisting of" to obviate these objections. For example, "... a gel-forming agent selected **from the group consisting of** fatty acids, fatty acid esters, cosmetically useful glycol derivatives and mixtures thereof;..." Please see M.P.E.P. § 2173.05(h) for further direction.

Claim 1 is objected to because of the following informalities: The list of colorants is not grammatically correct. Applicant may wish to consider altering

Art Unit: 1619

the claim, if appropriate, to "...7-15% by weight of pigments, powders with pigment like effects, or mixtures thereof..."

Claim 13 is objected to because it is a substantial duplicate claim 4. For example, glyceryl behenate and glycerol behenate are known by the artisan of ordinary skill in the art as generic names for the tradename Compritol 888. Glyceryl palmitate and glycerol palmitate both refer to the chemical substance assigned the CAS registry number 26657-96-5. Glyceryl stearate and glycerol stearate refer to the substance assigned the CAS registry numbers 123-94-4 and 11099-07-03.

Claims 13 and 14 are objected to because "glycerol arachidate" is not a proper chemical name that one of ordinary skill in the art would recognize. A google search demonstrated that only two references contained the chemical "glycerol arachidate." The first was Applicant's application, the second was US Patent No. 5,750,121. In both cases, no CAS registry number, or synonyms, were available to aid the artisan of ordinary skill in being able to ascertain which chemical is "glycerol arachidate."

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Art Unit: 1619

Claims 1-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The instant specification does not provide support for "cosmetically acceptable glycol derivatives," and thus instant claims 1, 11, and 15 introduce new matter.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-11 remain and claims 12-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "derivative" in claims 1, 11, and 15 is a term which renders the claims indefinite. The claims do not define what a "glycol derivative" is. Because claims 2-10 depend from indefinite claim 1, and claim 14 depends from claim 11, and do not clarify all of the points of confusion, they must also be rejected under 35 U.S.C. 112, second paragraph. Clarification is required.

The term "cosmetically acceptable glycol derivative" is a term which renders the claims indefinite. It is unclear what criteria a glycol derivative must have to be considered cosmetically acceptable. Clarification is required.

Remarks

Applicant alleges that cosmetically useful glycol derivatives can be found in the CTFA buyers guide and ingredients given a name under the INCI standards (Reply, page 6, paragraph 1).

Applicant's traverse has been considered but is not found persuasive. Glycol derivative is not defined by the claim. The metes and bounds of chemicals which may or may not be encompassed by the term "glycol derivatives" are unclear.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Art Unit: 1619

Invention Summary: The invention of the instant application is directed to a composition which is meant to be formulated as a mascara. The composition comprises oil and water phases. The oil phase comprises an ester or a liquid oil, a film former, gellant (i.e. fatty acids, fatty acid esters, glycol derivatives), and pigments or powders. The water phase comprises 42-75% water, 0.1-10% surface active agent, and auxiliary substances. The instant specification teaches that a preferred special gel former consisting of glyceryl stearate behenate and stearyl behenate may be preferably used in a 1:2 to 1:4 ratio.

Claims 1, 2, and 4-10 remain rejected and claims 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,318,774 (Alban, 1994), as evidenced by US Patent No. 4,873,078 (Edmundson, 1989), the Free Online Medical Dictionary reference for q.s. accessed 1/30/2009 from <http://medical-dictionary.thefreedictionary.com/q.s>, and US Patent No. 5,565,216 (Coswar, 1996), in view of US Patent No. 4,457,784 (Bernhard, 1984) and further in view of US Patent No. 5,571,503 (Mausner, 2002), US Patent No. 5,207,998 (Robinson, 1993), and US Patent No. 6,074,652 (Ishiwatari, 2000).

Example 1 (Col. 11 lines 5-55) of Alban discloses an oil-in-water emulsion, an artificial tanning lotion, which comprises the silicone oil, dimethicone [see evidentiary reference Edmundson (Col. 2, lines 40-45) for the disclosure that dimethicone is a silicone oil]. Hence, the composition comprises an "oil phase" (instant claims 1, 2, and 15). Example 1 (Col. 11 lines 5-55) of Alban embodies the gel-forming agent and moisturizing substance, butylene glycol, in an amount

Art Unit: 1619

of 2.0% by weight (instant claims 1, 5, 10, and 15). Alban teaches that polyhydroxy alcohols (such as butylene glycol) may comprise from 1-30% of the composition (Col. 8, lines 10-30; instant claims 1, 5, and 15).

Example 1 (Col. 11 lines 5-55) of Alban also embodies the gelling agent glyceryl stearate in an amount of 2.6% by weight (instant claims 4, 5, and 12-14). Alban teaches use of the fatty acid esters such as glyceryl behenate (tribehenin) "and the like." (Col. 5, lines 55-end). Alban teaches use of these fatty acid derivatives in an amount of from "about 0.5 to about 20%" (Col. 6 lines 10-25). Alban teaches that use of fatty acids in an amount from 1-10% is preferable and from 4-6% percent is most preferable (Col. 6 lines 10-25; instant claims 1 and 12).

Alban teaches use of optional pigments such as gums, resins, thickeners, preservatives, chelators, sequesterants, antioxidants, pigments and opacifiers for use in the composition (Col. 10, lines 50-65; instant claims 1 and 15). Alban exemplifies use of the auxiliary, fragrance, in an amount of 1.0% by weight in Example 1 (Col. 11 lines 5-55; instant claims 1 and 15). Alban teaches that these optional components are not limited to the examples he provides for the optional components (Col. 10, lines 50-65; instant claims 1 and 15). Alban also teaches inclusion of optional ingredients such as sunscreens in a safe or photoprotectively amount such as 0.5-20% by weight of the composition (Col. 7; lines 35-50; instant claims 1 and 15), humectants in an amount of 1-30% (Col. 8, lines 10-35; instant claims 1 and 15), copolymers in an amount of 0.025 -2.0%

Art Unit: 1619

(Col. 10, lines 1-10; instant claims 1 and 15), and emollients in an amount of 1-50% (Col. 10, lines 20-25; instant claims 1 and 15).

The composition of Example 1 of Alban comprises 73.62% by weight water. Thus, the emulsion comprises a water phase (instant claims 1, 7, 8, and 15). Alban teaches that a portion of the water, 8.0%, is required, but approximately 65% of it is "optional" and be added to adjust the proportions to a 100% (i.e. "water q.s." or "as much as is enough" as defined by the Free online medical dictionary)

Alban exemplifies use of the nonionic emulsifier (i.e. non-ionic surface active agent) Cetearth-20 [see Coswar (Col. 7 lines 30-45) for the disclosure that Cetearth-20 is a nonionic emulsifier] in an amount of 0.5% by weight of the Composition of Example 1 (Col. 11 lines 5-55; instant claims 1, 9, and 15).

With regard to the film forming agent, Alban exemplifies use of the film forming agent, trimethylsiloxysilicate and dimethicone (as DC 593 fluid), in an amount of 2.00% the weight of the composition (Col. 11 lines 10-55; instant claims 1, 6, and 15).

No waxes or hydrocarbon solvents are disclosed by Example 1 of Alban; therefore, it is free of waxes and hydrocarbon solvents.

Alban does not teach the range of pigment and powders with a pigment like effect being from 7 to 15% by weight and 1-50% by weight in the artificial tanning lotion as set forth by instant claims 1 and 15.

Bernhard teaches that nacreous pigments are used in the cosmetics industry in amount from 0.1 to 80% by weight. Tanning emulsions, UV screening

Art Unit: 1619

emulsions, and skin care lotions comprise nacreous pigments (column 5, lines 10-25).

With regard to instant claims 1 and 15, it would have been *prima facie* obvious to a person of ordinary skill in the art at the time the invention was made to have optimized the amount of pigment in artificial tanning lotion of Alban to comprise 7 to 15% or 1-50% by weight pigments and powders because Bernhard teaches that cosmetic lotions such as tanning emulsions, UV screening emulsions, and cosmetic lotions may comprise from 0.1 to 80% by weight pigment. The adjustment of the amount of pigment to between 7 to 15% by weight or 1-50% by weight is deemed merely a matter of judicious selection and routine optimization within the range of pigments for cosmetic lotions and pigments taught by Bernhard, which is well within the purview of the ordinary artisan.

Alban does not teach the fatty acid esters glyceryl palmitate or glyceryl arachidate, nor does Alban teach use of fatty acid esters in an amount from 0.1 to about 10% as set forth by instant claims 1 and 4.

Mausner teaches that glyceryl stearate, glyceryl palmitate, and glyceryl arachidate are long chain fatty acid esters which may included in the antipollution cosmetics (Col. 2 lines 50-63), thus Mausner teaches glyceryl palmitate and glyceryl arachidate as equivalents of glyceryl stearate. In a preferred cosmetic composition, Mausner teaches used of glyceryl stearate in an amount of about 0.1 to about 2.0% (Col.4, lines 35-end; Col. 5, lines 1-50). Mausner teaches use

Art Unit: 1619

of glyceryl stearate in an amount of 0.1-2.0% in a lotion (Table II, Columns 15 and 16).

It therefore would have been obvious to a person of ordinary skill in the art at the time the invention was made to substitute glyceryl behenate (tribehenin) for glyceryl stearate as the fatty acid ester gel forming agent of Example 1 because Alban teaches these reagents as equivalents. The skilled artisan would have been motivated to do so because Alban invites routine optimization by teaching that fatty acid esters such as glyceryl behenate (tribehenin) "and the like." (Col. 5, lines 55-end) may be used in the invention.

It therefore would have been obvious to a person of ordinary skill in the art at the time the invention was made to substitute glyceryl behenate for glyceryl stearate as the fatty acid ester gel forming agent of Example 1 of Alban because Alban teaches these reagents as equivalents that may be used in the invention.

With regard to the species of glyceryl palmitate and glyceryl arachidate, it therefore would have been obvious to a person of ordinary skill in the art at the time the invention was made to substitute glyceryl palmitate and glyceryl arachidate for glyceryl stearate as the fatty acid ester gel forming agent of Example 1 because Mausner teaches both glyceryl palmitate and glyceryl arachidate as equivalents of glyceryl stearate. The skilled artisan would have been motivated to do so because Alban invites routine optimization by teaching that fatty acid esters other than glyceryl behenate and glyceryl stearate may be used in Alban's composition by teaching the fatty acid esters may be glyceryl behenate (tribehenin) "and the like."

Art Unit: 1619

It therefore would have been obvious to a person of ordinary skill in the art at the time the invention was made substitute either glyceryl palmitate or glyceryl arachidate for glyceryl stearate because Mausner teaches glyceryl palmitate or glyceryl arachidate to be equivalents which may be used in cosmetic compositions.

With regard to the range of gelling agent (i.e. fatty acid ester used), Mausner teaches use of the fatty acid ester, glyceryl stearate, in an amount of 0.1-2.0% in a lotion (Table II, Columns 15 and 16), while Alban teaches use of the fatty acid esters in an amount of "about 0.5 to about 20%" (Col. 6 lines 10-25).

With regard to instant claim 1, a person of ordinary skill in the art would have had a reasonable expectation of success in optimizing the composition taught by Alban by optimizing the amount of the fatty acid ester gelling agent in the composition within the prior art ranges (i.e. conditions) of 0.1 to about 20% because Mausner teaches that fatty acid gelling agents may be used as low 0.1-2.0% in lotion compositions and Alban teaches use of fatty acid ester in 0.5 to about 20%. The skilled artisan would have been motivated to do so because Alban invites routine optimization by teaching that the amount of fatty acid esters for use in the composition may be "about" 0.5% to "about" 20.0 %.

It therefore would have been obvious to a person of ordinary skill in the art at the time the invention was made to optimize the amount of fatty acid ester gelling agents used in Example 1 of Alban to be between 0.1-20% by weight

Art Unit: 1619

based upon the teachings of the prior art ranges for fatty acid gelling agents by Mausner and Alban.

With regard to the gelling agents being included in a concentration of 0.1-5% or 1.0-4.5% as set forth by instant claims 5 and 12, the selection of 1-5% or 1.0-4.5% by weight gelling agent would have been a routine matter of optimization on the part of the artisan of ordinary skill, said artisan recognizing that fatty acid gelling agents may be used in topical oil in water emulsions in the form of a lotion compositions in an amount of 0.1-20% by weight based on the prior art teachings of Mausner and Alban. A holding of obviousness over the cited claims is therefore clearly required.

Alban does not teach a range for the amount surfactant/emulsifier (Ceteareth-20) in the composition.

Robertson teaches that Ceteareth-20 is an emulsifier which may be present in amount between 0.1-10% by weight (Col. 8, lines 40-55) in suncare compositions delivered by topical carriers which are emulsions (Col. 2, lines 60-end), such as lotions (Col. 4 lines 45-65).

The selection of an amount of 0.1-10% by weight Ceteareth-20 would have been a routine matter of optimization on the part of the artisan of ordinary skill, said artisan recognizing that Ceteareth-20 may be used in an amount of 0.1-10% by weight of emulsions which are topically applied to the skin, such as lotions as taught by Robertson. A holding of obviousness over the cited claims is therefore clearly required.

Alban does not teach a range of water for the emulsion.

Art Unit: 1619

The selection of Example 1 by Alban comprising 42-75%, 50-75%, and 56-75% water would have been a routine matter of optimization on the part of the artisan of ordinary skill, said artisan recognizing that Alban teaches that water may be added or subtracted as needed (i.e. "q.s.") based upon the reagents included in the composition. Alban teaches that the composition requires 8% water, the remaining amount may be varied as needed (Example 1, Col 11, lines 10-60). A holding of obviousness over the cited claims is therefore clearly required.

Alban teaches a silicone fluid comprising dimethicone and trimethylsiloxysilicate.

Alban does not teach that the composition comprises a film forming agent, trimethylsiloxysilicate, from 1 to 50% or 15 to 30% by weight, for use in the artificial tanning lotion which is an oil-in-water emulsion as set forth by instant claims 1 and 15.

Ishiwatari teaches that trimethylsiloxysilicate is a silicone film forming agent (Col. 25, lines 55-60). Ishiwatari recommends use of trimethylsiloxysilicate in an amount of 0.01 to 50% in order to improve the effect of water resistance (Col. 24 lines 30-45) of oil in water emulsions (abstract).

With regard to instant claims 1 and 15, the selection of 1-50% by weight or 15 to 30% by weight of the film forming agent, trimethylsiloxysilicate, would have been a routine matter of optimization on the part of the artisan of ordinary skill, said artisan recognizing that an amount of 0.01-50% trimethylsiloxysilicate may be used in oil in water emulsions, such as the artificial tanning lotion of Alban, as

Art Unit: 1619

taught by Ishiwatari in order to improve the effect of water resistance. A holding of obviousness over the cited claims is therefore clearly required.

Alban does not embody further carrier substances, auxiliaries, and active agents or mixtures thereof in Example 1 as set forth by instant claims 1 and 15.

A person of ordinary skill in the art would have had a reasonable expectation of success in optimizing Example 1 of Alban through inclusion of optional components such as sunscreens, copolymers, humectants and emollients in an amount to add 100% because Alban teaches these optional components may be included in the composition (Col. 6, lines 30-45). The skilled artisan would have been motivated to do so because Alban invites optimization of the composition by teaching that these reagents may be included.

Furthermore, Alban invites optimization of ranges by stating that the reagents may be included in ranges that are "about" some specified range, providing further motivation to the skilled artisan. For example, the composition may comprise about 1% to about 30% by weight moisturizer or humectant (Col. 8 lines 10-20).

It therefore would have been obvious to a person of ordinary skill in the art at the time the invention was made to optimize the composition taught by Example 1 of Alban to include optional reagents in an amount of ad 100% because Alban teaches that these reagents may be optionally included in amounts which may be optimized.

With regard to the properties of Alban's emulsion exhibiting no statistically increased amount of streaking, smudging, or flaking after immersion in water, it is

Art Unit: 1619

noted that Alban's composition is a water in oil emulsion. The artisan of ordinary skill would expect, when a drop of Alban's composition is dropped (i.e. immersed) in water that the droplet would not streak, smudge, or flake due to the hydrophobic interaction of the oils in the emulsion.

Claim 3 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Alban, Coswar, Mausner, Robinson, and Ishiwatari, and Bernhard, as evidenced by the Free Online Medical Dictionary reference for q.s. accessed 1/30/2009 from <http://medical-dictionary.thefreedictionary.com/q.s> and Edmundson, as applied to claims 1, 2, and 4-10, and 12-15 above, further in view of US Publication No. 2002/0085984 (DiGirolamo, 2002).

The teachings of Alban, Coswar, Mausner, Robinson, Ishiwatari, and Bernhard are relied upon as above. Furthermore, Alban teaches that the oil in water compositions of the invention comprise an oil phase which contains at least one fatty acid or fatty acid derivative (abstract).

However, Alban does not teach a composition comprising diisostearyl maleate as an ester in the oil phase as set forth by instant claim 3.

DiGirolamo teaches a cosmetic composition comprising diisostearyl maleate (paragraph 12). DiGirolamo teaches that diisostearyl maleate is a "feel enhancing agent" (paragraph 12).

A person of ordinary skill in the art would have had a reasonable expectation of success in modifying the cosmetic composition taught by Alban by adding diisostearyl maleate as taught by DiGirolamo because DiGirolamo

Art Unit: 1619

teaches that diisotearyl maleate may be added to cosmetic compositions. The skilled artisan would have been motivated to do so in order to modify the feel of the composition since DiGirolamo teaches that diisotearyl maleate is a "feel enhancing agent."

It therefore would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Alban's composition by adding diisotearyl maleate because DiGirolamo teaches that diisotearyl maleate in cosmetic compositions enhances the feel of the composition.

Therefore, the invention as a whole would have been prima facie obvious to a person of ordinary skill at the time the invention was made.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Alban, Coswar, Mausner, Robinson, Ishiwatari, Bernhard and DiGirolamo, as evidenced by the Free Online Medical Dictionary reference for q.s. accessed 1/30/2009 from <http://medical-dictionary.thefreedictionary.com/q.s> and Edmundson, as applied to claims 1-10, and 12-15 above, further in view of US Patent No. 6,391,835 (Gott, 2002), US Patent No. 5,013,763 (Tubesing, 1991) US Patent No. 5,126,136 (Merat, 1992), US Patent No. 6,033,648 (Candau, 2000), and US Patent No. 6,296,860 (Hasegawa, 2001).

The combined references teach an oil in water emulsion which comprises an oil phase, a gel-forming agent and moisturizing substance, butylene glycol, in an amount of 2.0% by weight and glyceryl stearate (i.e. a mixture thereof of fatty acid ester and cosmetically acceptable glycol derivative). Alban teaches use of

Art Unit: 1619

optional pigments such as pigments and opacifiers for use in the composition (Col. 10, lines 50-65; instant claims 1 and 15). The composition of Example 1 of Alban comprises 73.62% by weight water. Thus, the emulsion comprises a water phase. Alban teaches that a portion of the water, 8.0%, is required, but approximately 65% of it is "optional" and be added to adjust the proportions to a 100% (i.e. "water q.s." or "as much as is enough" as defined by the Free online medical dictionary) Alban exemplifies use of the nonionic emulsifier (i.e. non-ionic surface active agent) Ceteareth-20 [see Coswar (Col. 7 lines 30-45) for the disclosure that Ceteareth-20 is a nonionic emulsifier] in an amount of 0.5% by weight of the Composition of Example 1 (Col. 11 lines 5-55; instant claims 1, 9, and 15). With regard to the film forming agent, Alban exemplifies use of the film forming agent, trimethylsiloxysilicate and dimethicone (as DC 593 fluid), in an amount of 2.00% the weight of the composition (Col. 11 lines 10-55; instant claims 1, 6, and 15). The combined references teach inclusion of the liquid ester, diisostearyl palmitate to improve the feel of the composition. Alban invites modification of the composition by experimentation by teaching inclusion of optional ingredients in the water and oil phase (column 6, lines 35-45).

The combined references do not teach inclusion a film forming agent on a silicone base in an amount of 15 to 30% by weight of as set forth by instant claim 11.

The combined references do not teach the species of pigments or the amount of pigments for inclusion in the composition as set forth by instant claim 11.

Art Unit: 1619

The combined references do not embody a water phase from 45 to 70% by weight water as set forth by instant claim 11.

The combined references do not teach 0.8 to 2% by weight of a cationic silicone polymer as set forth instant claim 11.

With regard to the amount of water in the composition, it would have been *prima facie* obvious to a person of ordinary skill in the art at the time the invention was made to have looked to the teachings of Alban and added 45 to 70% water to the composition because Alban teaches inclusion of water in an amount from 8 to 73.6% water by weight. The adjustment of particular conventional working conditions (e.g. determining the amount of water taught by the cited references) is deemed merely a matter of judicious selection and routine optimization which is well within the purview of the ordinary artisan.

With regard to inclusion of a silicone based film forming agent in an amount from 15-30% by weight of the composition, Candau teaches an artificial tanning lotion (title). The tanning lotion comprises 5 to 40% of a film forming polymer (column 9, lines 60-end) which may be a polyurethane which may comprise a least one branched or unbranched silicone structural unit (e.g. polydimethylsiloxane or polymethylsiloxane; column 8, lines 35-60). Candau teaches that film forming polymers improve the persistence of the coloration on skin and the fastness of the of the composition toward water (column 7, lines 35-65).

It would have been *prima facie* obvious to a person of ordinary skill in the art at the time the invention was made to have modified the tanning lotion

Art Unit: 1619

composition of the combined references by adding the polyurethane/silicone copolymeric film forming agent (i.e. film forming agent on a silicone base) taught by Candau to the composition because Candau teaches that polyurethane/polydimethylsiloxane copolymeric film forming agent increases the waterfastness and colorfastness of artificial tanning lotion to the skin when used in an amount of 5-40% by weight of the composition. One would have been motivated to select the polyurethane which comprises polydimethylsiloxane due to its feel and emollient properties. The adjustment of particular conventional working conditions (e.g. determining the amount of film forming polyurethane/polydimethylsiloxane copolymer to use in an artificial tanning lotion) is deemed merely a matter of judicious selection and routine optimization, within the range taught by Candau, which is well within the purview of the ordinary artisan.

With regard to the amount of pigments to include in the composition, Hasegawa teaches coated pigments and extended pigments for cosmetics (title). Hasegawa teaches that his coated pigments and extender pigments have a smooth feeling when used in cosmetics and excellent cohesion to the skin (column 2, lines 45-55). Hasegawa goes on to teach that the coated pigments and extender pigments may be used in lotions (column 8, lines 55-end). Hasegawa teaches that the amount of pigments and extender pigments for inclusion in cosmetics may range from 0.01 to 100% weight based on the total composition (column 8, lines 35-45). Hasegawa goes on to teach that preferably not less than 50% of the pigments and extender pigments are coated (column 8,

Art Unit: 1619

lines 45-55). Thus Hasegawa teaches that 0.05 to 50% of the pigments included in the cosmetics compositions are coated pigments.

It would have been *prima facie* obvious to a person of ordinary skill in the art at the time the invention was made to have added 1 to 15% coated pigments to the lotion taught by the combined references because Alban teaches that pigments may be included in the lotion composition and Hasegawa teaches inclusion of 0.05 to 50% coated pigments and coated extended pigments for lotions. The artisan of ordinary skill at the time the invention was made would have been motivated to add the coated pigments and coated extender pigments to the lotion because Hasegawa's coated extender pigments and coated pigments adhere well to the skin and feel good. The adjustment of particular conventional working conditions (i.e. the amount of coated pigment for inclusion in the cosmetic) is deemed merely a matter of judicious selection and routine optimization within the range taught by Hasegawa which is well within the purview of the ordinary artisan.

With regard to inclusion of cationic silicone polymers in the composition, Gott teaches that amodimethicone is a "cationized" silicone polymer (Col.6, lines 30-45).

Tubesing teaches that amodimethicone is a substantive silicone for skin preparations which may comprise 0.1 to 8% by weight of the skin preparation (Col. 4 lines 10-25) which may be topical skin formulation such as a lotion (Col. 4 lines 40-50).

Art Unit: 1619

Merat teaches that amodimethicone is a non-slip binding agent which may be used in topical compositions such as lotions (Col. 4, lines 25-40).

A person of ordinary skill in the art would have had a reasonable expectation of success in improving the composition taught by the combined references by adding amodimethicone as a non-slip binding agent as taught by Merat. The skilled artisan would have been motivated to do so because Tubesing and Merat both teach use of amodimethicone for use in compositions applied to the skin such as lotions and Merat teaches amodimethicone's use as a binding agent for topical compositions.

With regard to the amount of amodimethicone to add to the composition of the combined references, the selection of 0.8 to 2% use amodimethicone would have been a routine matter of optimization on the part of the artisan of ordinary skill, said artisan recognizing that use of amodimethicone in topical preparations applied to the skin may range from 0.1 to 8% by weight as taught by Tubesing.

Response to Arguments

The claimed invention is directed to a wax and hydrocarbon-free mascara. The instant specification teaches that the mascara is a cream-like emulsion (paragraph 36). As currently claimed, the reagents and percentages of reagents in the invention read on topical lotions, such as the artificial tanning lotion which are also emulsions. Since Applicant teaches that their formulation is cream-like, a particular challenge for applicant may be identifying how their composition

Art Unit: 1619

differs from a waterproof sun-tanning lotion rather than a waterproof mascara.

The instant specification teaches that a preferred special gel former consisting of glyceryl behenate and stearyl behenate may be preferably used in a 1:2 to 1:4 ratio. A cursory search of the prior art suggests that patentability may lie with inclusion of both glyceryl behenate and stearyl behenate in the specified ratio. However, the prior art teaches use of glyceryl behenate and stearyl behenate, individually as emulsifiers for emulsions, thus it would be obvious to combine them as they have the same purpose in cosmetic emulsions. Applicant may wish to consider, if appropriate, amending their claims to include a recitation of the specific combination glyceryl behenate and stearyl behenate, in the specified ratio to produce the special gel former. Applicant may wish to consider whether it is inclusion of these reagents together, in that particular ratio range, which contribute over the prior art.

Applicant argues that Alban is not drawn to water-proof mascaras and that the modifications proposed in the 103 rejections under 35 USC 103 render the composition unsuitable for Alban's intended use (page 13, paragraph 2; page 12, paragraph 2; page 9, paragraph 3). Applicant also alleges hindsight reasoning (page 9, paragraph 3).

In response to applicant's argument that the composition is a mascara, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the limitations of the claim.

With regard to the proposed modifications rendering the composition inoperable for its intended use, the cited references were drawn from the topical emulsion/lotion art, thus the taught modification would not render Alban's composition inoperable. Additional references were also supplied to teach chemical properties of some reagents. This art is still applicable because it is teaching a chemical property. Furthermore, M.P.E.P. § 2123 states, "Patents are prior art for all they contain."

With regard to hindsight reasoning, in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicant alleges that pigments are an absolute necessity in every mascara composition (page 10, paragraph 5).

Applicant's traversal has been considered but is considered unpersuasive. As evidenced by the post by "TheLady" regarding the "Mascara" thread, clear mascara (i.e. mascara without pigment) was commercially available for inclusion in a "person's war paint arsenal" to emphasize the eyes as early as 2001 and was good choice of mascara for those who are fair skinned (pages 1 and 2).

Art Unit: 1619

Applicant traverses the use of Edmundson, Cowsar, Ishiwatari, and Robinson (Reply, page 11, paragraphs 4 and 5; page 12, paragraph 2; page 13, paragraph 1) to teach inherent chemical properties (i.e. dimethicone is a silicone oil and cetareth is a non-ionic emulsifier). In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Furthermore, M.P.E.P. § 2123 states, "Patents are prior art for all they contain."

Applicant traverses the Grollier reference (page 12, paragraph 3).

Applicant's traverse is moot in view of the new ground(s) of rejection. In particular, applicant's amendment of instant claim 1, removed the previous limitation of the range of further carrier substances, auxiliaries, active agents, or mixtures thereof for inclusion in the composition. As such, the Grollier reference is no longer needed to teach the range of amounts of carrier substances, auxiliaries, active agents, or mixtures in a lotion/topical emulsion.

Applicant alleges that Lawson is not applicable prior art because Lawson teaches a low oil content and is not drawn to an emulsion (Reply, page 14, paragraphs 2, 3, and 5). Applicant further alleges that pigments are emulsion breakers (Reply, page 12, paragraph 2; page 14, paragraph 3).

Art Unit: 1619

Applicant's arguments have been considered but they are unpersuasive. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that the composition is in the form of an emulsion) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

With regard to pigments being emulsion breakers, as discussed above, instant claim 11 does not require the formulation to be an emulsion. Furthermore, as evidenced by Bernhard (above) pigments may be included in cosmetic emulsions such as tanning, UV, and skin care emulsions/lotions in amounts up to 80% by weight. This teaching suggests that it was within the skill of an ordinary artisan to formulate emulsions with a high load of pigment, despite their alleged emulsion breaking tendencies.

Conclusion

No claims are allowed. No claims are free of the art.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is

Art Unit: 1619

filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LORI MATTISON whose telephone number is (571)270-5866. The examiner can normally be reached on 8am-6pm (Monday-Thursday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571)272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/LORI MATTISON/

Examiner, Art Unit 1619

/Anne Marie Grunberg/

Supervisory Patent Examiner, Art Unit 1638